

the Office narrowed the scope of the subject matter of claims 1-6, 21, and 22, in view of our provisional election of a species, *i.e.*, the compound of Example 66 disclosed on page 18 of the published specification, 2,2-difluoro-benzo[1,3]dioxol-5-carboxylic acid indan-2-ylamide. On that basis, the Office alleged that the "generic concept of the elected subject matter of claims 1-6, 21[,] and 22" is the compound of claim 1, wherein certain substituents have been excluded. *Id.* at page 3. The Office further indicated that claims 1-6, 21, and 22 would be allowable if they were amended to the "generic concept" as set forth at page 3 of the Office Action. *Id.* at page 4. Applicants respectfully submit that the Office's Objection is incorrect for at least the following reasons.

First, the Office arbitrarily defined the "generic concept" of the elected subject matter of claims 1-6, 21, and 22, *i.e.*, it narrowed the scope of the claims 1-6, 21, and 22, without providing any support thereof.

Second, the Office may require a provisional election of a single species prior to examination on the merits, but the provisional election will be given effect only when the claims are found not allowable. See M.P.E.P. § 803.02 (emphasis added). In other words, if no reference is found to anticipate or render the elected species obvious, the Office has the burden to extend the search. *Id.* (emphasis added). In this case, as the Office failed to find any reference to anticipate or render claims 1-6, 21, and 22 (as restricted to the elected species) obvious, the Office has not met its burden to extend the search as required by the M.P.E.P. The Office cannot arbitrarily narrow the scope of these claims based on the elected species and require amendment of these claims for allowance.

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Therefore, Applicants respectfully request the Office extend the search until claims 1-6, 20, and 21 are found not allowable based on prior art reference(s), or otherwise, allow claims 1-6, 20, and 21 as currently presented.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application, and the timely allowance of the claims 1-6, 20, and 21.


If the Examiner believes a telephone conference could be useful in resolving the outstanding issue, please contact Applicants' undersigned counsel at 202-408-4218.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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